

**REMARKS**

Claims 1-24 are pending in the Application.

Claims 1-24 stand rejected.

Claims 1, 11, and 12 are canceled without prejudice or disclaimer.

Claim 2 has been re-written in independent form incorporating the limitations of Claim 1 and clarifying the claim language to address the indefiniteness issue raised by the Examiner.. Claim 3 is amended to correctly depend from amended Claim 2.

Claim 13 has been written in independent form incorporating the limitations of Claims 11 and 12 and also clarifying the claim language to address the indefiniteness issue raised by the Examiner. Claims 14-17 are amended to correctly dependencies.

**I. REJECTION UNDER 35 U.S.C. § 112, ¶ 2**

Examiner has rejected Claims 1-24 under 35 U.S.C. § 112, ¶ 2 as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Office Action, at 2.

Applicants have cancelled Claims 1, 11 and 12 without prejudice or disclaimer and thus the rejections of these claims have been rendered moot.

As to the remaining claims (Claims 2-10, and 13-24), Applicants have amended the independent claims (Claims 2 and 13) to clarify that “said ‘V’ points to a shoulder of said first hand of a [or said] golfer.” The Applicants respectfully assert that the amendments these claims and incorporated by reference in any claims depending therefrom, are not narrowing amendments made for a reason related to the statutory requirements for a patent that will give rise to prosecution history estoppel. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S. Ct. 1831, 1839-40,

62 U.S.P.Q.2d 1705, 1711-12 (2002); 234 F.3d 555, 566, 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2001).

Accordingly, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. § 112, ¶ 2

## **II. REJECTION UNDER 35 U.S.C. § 102**

The Examiner has rejected Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,542,126 to Park (hereafter “*Park*”). The Examiner has further rejected Claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,698,027 to *Harvanek* (hereafter “*Harvanek*”). Office Action, at 2

Claim 1 is canceled without prejudice or disclaimer and thus the rejections of Claim 1 have been rendered moot.

## **III REJECTION UNDER 35 U.S.C. § 103**

The Examiner has rejected Claims 2-5, and 8 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of U.S. Patent No. 4,665,565 to *Odom* (hereafter “*Odom*”). Office Action, at 3-5 Although not specifically stated, the Applicants assume that Claims 6-7 and, 9-10 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom*. *Id.* However, for Claims 6 -7 and 9-10, the Examiner only argues relative to *Odom*. The Examiner has further rejected Claims 12-24 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom*. *Id.* Applicants traverse these rejections.

To establish a *prima facie* case of obviousness, at least three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of

success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *see also* M.P.E.P §§ 2143-2143.03.

All three of these basic criteria are missing here.

**Claim 2.** Amended Claim 2 is now an independent claim directed to a golf teaching aid comprising a first golf glove having a visual alignment feature, a first attachment feature on a first glove surface area of the first golf glove, and a second golf glove having a second attachment feature on a second glove surface area, wherein said first attachment feature couples to said second attachment feature when said second hand inserted in said second golf glove overlays said first hand inserted in said first golf glove while gripping a golf club.

The Examiner states that *Harvanek* fails to show first and second attachment features of the golf gloves (golf gloves disclosed by *Harvanek*). Office Action, at 2. The Examiner states that *Odom* shows a first attachment feature 46 (FIG. 5 of *Odom*) on the first glove and a second attachment feature 46 on the second glove (not shown but implied), wherein the second glove is a "mirror image" of the first glove and cites *Odom* column 1, lines 37-45. *Id.* According to *Odom*, column 3, beginning at line 32, FIGS. 5 and 6 show a modified form of his invention wherein a golf club 40 includes a golf grip 42 having a loop fastener strip 44 attached around the entire part of its outer periphery. Likewise, *Odom* discloses that a cooperating fastener pile 46 is attached to the palm 48 of a golf glove 50 so that when golf club 40 is gripped by the golfer (using golf glove 48) the palm fastener 46 on golf glove 48 and the fastener pile 44 on golf grip 42 mesh thereby locking the golf glove 50 to golf grip 42. Relative to Fig. 5, *Odom* is disclosing how his modified golf glove 50 locks to a modified grip 42 on a golf club 40. Claim 2 is a teaching aid whereby features of first glove on one hand couple to features on a second glove on a golfer's other hand. Claim 2 does not recite coupling a glove to a modified grip as disclosed relative to

Fig. 5 of *Odom*. Mirror image gloves with attachment elements 46 do not form a first attachment feature on a first glove and a second attachment feature on a second glove that couple when the first and second gloves are overlaid while gripping a standard golf club grip. Element 46 of *Odom* only works with a modified golf grip 42. Claim 2 has no modified golf grip and has golf gloves that are coupled by the first attachment feature of the first golf glove coupling with the second attachment feature of the second golf glove. *Harvanek* discloses alignment markings but does not disclose any attachment features, and in particular does not disclose the first attachment feature on a first golf glove and a second attachment feature on a second golf glove that couple when the first and second glove overlay while gripping a golf club. Combining the teachings of *Harvanek* with the teachings of *Odom* does not lead to the invention of Claim 2. *Odom* teaches two identical mirror image golf gloves with no alignment features and no attachment features for coupling the two gloves. *Harvanek* teaches alignment markings and not attachment features of any kind. Therefore, the Applicants respectfully assert that the rejection of Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments.

**Claim 3.** Claim 3 is dependent from Claim 2 and contains all the limitations of Claim 2. Claim 3 adds the limitations locating the first attachment feature on the first glove and the second attachment feature on the second glove. Claim 3 recites that the first attachment feature is on the first golf glove is on an area above a top of a thumb of a first hand inserted into said first golf glove and the second attachment feature of the second golf glove is on a glove surface area above the palm surface of a second hand inserted into the second golf glove. Further, the first attachment feature couples to the second attachment feature when the second hand inserted in the second golf glove overlays the first hand inserted in the first golf glove while gripping a golf club. The Examiner states that *Odom* shows a first attachment feature as a portion of fastener 46 that is positioned on the thumb area on a glove surface area and cites Fig. 5 for support. Office Action, at 4. According to *Odom*, column 3, beginning at line

32, FIGS. 5 and 6 show a modified form of his invention wherein a golf club 40 includes a golf grip 42 having a loop fastener strip 44 attached around the entire part of its outer periphery. Likewise, *Odom* discloses that a cooperating fastener pile 46 is attached to the palm 48 of a golf glove 50 so that when golf club 40 is gripped by the golfer (using golf glove 48) the palm fastener 46 on golf glove 50 and the fastener pile 44 on golf grip 42 mesh thereby locking the golf glove 50 to golf grip 42. Relative to Fig. 5, *Odom* is disclosing how his modified golf glove 50 locks to a modified grip 42 on a golf club 40. Claim 2 is a teaching aid whereby features of first glove on one hand couple to features on a second glove on a golfer's other hand. Claim 3 does not recite coupling a glove to a modified grip as disclosed relative to Fig. 5 of *Odom*. Relative to Fig. 5, *Odom* does not show a first golf glove having a first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove. Fig. 5 only shows and *Odom* only discloses relative to Fig. 5 a single attachment feature on the palm surface of glove 50 that couples to a cooperating feature on the golf grip 42 of golf club 40. The Examiner states that with respect to the second attachment feature, column 1 lines 37-45 of *Odom* indicates that there are a pair of gloves that are mirror images. In column 1, lines 37-45, *Odom* states that each of his left and right golf gloves (of his present invention) are mirror images of each other. The first and second golf gloves of Claim 3 are not mirror images of each other. One of ordinary skill in the art will not arrive at the first and second golf gloves recited in Claim 3 using a left hand golf glove 50 of Fig. 5 and a corresponding "mirror image" right hand golf glove. Left hand golf glove 50 of Fig. 5 does not have the first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove and therefore a "mirror image" right hand golf glove corresponding to golf glove 50 also would not have the first attachment feature recited in Claim 3. *Odom* teaches two identical mirror image golf gloves with no alignment features and no attachment features for coupling the two gloves. *Harvanek* teaches alignment markings and not attachment features of any kind. Therefore, the Applicants respectfully assert that the rejection of Claim 3 under

35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments.

**Claim 4.** Claim 4 is dependent from Claim 3 and contains all the limitations of Claim 3. Claim 4 adds the limitation that the first golf glove has a first location feature on a glove surface area above a palm surface of the first hand inserted into the first golf glove, the first location feature for locating a shaft of the golf club to the palm surface of the first hand when the golfer grips the golf club. The Examiner states that *Odom* shows a first location feature on the first glove (46) above the palm surface. The Examiner further states that Fig. 5 shows the area above the palm and the Examiner states that this area is considered a first location. Office Action, at 4. Claim 3 recites a first golf glove having a first attachment feature on a glove surface area above a top of a thumb of a first hand inserted into said first golf glove and a second golf glove having a second attachment feature on a glove surface area above the palm surface of a second hand inserted into said second golf glove. In addition, Claim 4 adds the limitation that the first golf glove has a first location feature on a glove surface area above a palm surface of the first hand inserted into the first golf glove, the first location feature for locating a shaft of the golf club to the palm surface of the first hand when the golfer grips the golf club. Relative to Claim 2, the Examiner states that the first attachment feature is element 46 and relative to Claim 4, the Examiner states that the first location feature is also element 46. Clearly, in the present invention, the first attachment feature is located on a glove surface area above the top of the thumb of the first hand inserted in the first golf glove and the first location feature is located above a palm surface of the first hand inserted into the first golf glove. The first attachment feature and the first location feature are two distinct elements in Claim 4. The Examiner has contradicted itself in stating the first attachment feature and the first location feature are element 46 of Fig. 5, wherein element 46 is an attachment feature used to couple to a cooperative feature 42 on golf club 40. See *Odom*, column 3, lines 32-44. Element 46 of *Odom* offers no help to a golfer in locating his hands on a golf club shaft. Element 46 of *Odom* broadly

extends over nearly the entire palm surface of each of his glove 50 and his corresponding “mirror image” golf glove not shown. The cooperating element 42 on golf club 40 extends over the entire periphery of the grip and couples to element 46 but does not aid in locating the golfer’s hand and thus is not a location feature. The Applicants assert that nowhere in the disclosure does *Odom* disclose a first location feature as recited in Claim 4 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests a first location feature as recited in Claim 4 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments.

**Claim 5.** Claim 5 is dependent from Claim 4 and contains all the limitations of Claim 4. Claim 5 adds the limitation that the first golf glove has a third attachment feature on a glove surface area above and adjacent to a top surface of an index finger of said first hand when inserted into said first golf glove. The Applicants have shown that *Odom* does not anticipate the invention of Claim 4. The invention of Claim 5 comprises a first golf glove with first and third attachment features and a first location feature and a second golf glove with a second attachment feature that couples to the first attachment feature. The Examiner states that “part of attachment element (46) located on the index finger is considered the third attachment feature.” Office Action, at 4. First, *Odom* discloses a single golf glove 50 that has a single attachment feature 46 that *Odom* states preferably extends along the palm side of the middle, ring, and little fingers. The first golf glove of Claim 5 has a first attachment feature on the top side of the thumb of the first golf glove, a first location feature located above the palm surface of the first hand inserted into the first golf glove, and a third attachment feature on a glove surface area above and adjacent to a top surface of an index finger of said first hand when inserted into said first golf glove. The Examiner considers part of element 46 (which is entirely on the palm surface of the glove hand and finger areas) to be the third attachment feature recited in Claim 5. Golf glove 50 shown in Fig. 5 of *Odom* has a single attachment feature (46) that *Odom* states preferably

extends along the palm side of the middle, ring, little fingers, and the thumb. The third attachment feature is disposed on the glove surface area above and adjacent to a top surface of an index finger of the first hand not as “part of element 46 which is on the palm side of the index finger” as cited by the Examiner. Nowhere does *Odom* disclose a first attachment feature, a third attachment feature, and a first location feature on a first glove along with a second glove with a second attachment feature. Nowhere does *Odom* disclose any embodiment with a first location feature on a first glove for locating a shaft of the golf club to the palm surface of the first hand when the golfer grips the golf club using the first glove. The Applicants assert that nowhere in the disclosure does *Odom* disclose the third attachment feature as recited in Claim 5 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests a third attachment feature as recited in Claim 5 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments.

**Claim 6.** Claim 6 is dependent from Claim 5 and contains all the limitations of Claim 5. Claim 6 adds the limitation that the second golf glove has a fourth attachment feature on a glove surface area above and adjacent to a palm surface of a little finger of the second hand inserted into the second golf glove. The Applicants have shown that *Odom* does not disclose the invention of Claim 4. The Examiner states that *Odom* discloses Claim 6 and states that the part of attachment element (46) located on the little finger is considered as the fourth attachment feature. Office Action, at 4. According to Claim 6, the fourth attachment is on the second glove along with the second attachment feature. Attachment feature 46 is located on golf glove 48 according to *Odom*, column 3, lines 32-44. Golf glove 48 does not have the first attachment feature and the first location feature recited. Attachment feature 46 is on a single golf glove 48. Likewise, a “mirror image” golf glove corresponding to golf glove 48 does not have the first attachment feature and the first location feature. The Applicants assert that nowhere in the disclosure does *Odom* disclose the fourth

attachment feature as recited in Claim 6 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests the fourth attachment feature as recited in Claim 6 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments.

**Claim 7.** Claim 7 is dependent from Claim 6 and contains all the limitations of Claim 6. Claim 7 adds the limitation that the third attachment feature couples to and is retained by the fourth attachment feature when the little finger overlays the index finger as the second hand inserted in the second golf glove overlays the first hand inserted in the first golf glove while gripping a golf club. The Examiner did not specifically address Claim 7 except to reject Claim 7 for the same reasons as the Examiner rejected Claim 6. Office Action, at 4. The Applicants assert that nowhere in the disclosure does *Odom* disclose the function of the third attachment feature and the fourth attachment feature as recited in Claim 7 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests the invention of Claim 7 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments and for the same reasons as Claim 6.

**Claim 8.** Claim 8 is dependent from Claim 3 and contains all the limitations of Claim 3. Claim 8 adds the limitation that the first and second attachment features are mating elements selected from a group consisting of a hook and loop attachment system, a magnetic attachment system, or a selective, separable adhesive based attachment system. The Examiner states that *Odom* discloses attachment features consisting of a hook and loop attachment system. Office Action, at 5. However, the Applicants have shown that *Odom* does not disclose a first golf glove with the first attachment feature and a second golf glove with the second attachment feature as recited by Claim 8. The Applicants are not claiming a simple hook and loop attachment system, rather, the Applicants are claiming the specific first and second

golf gloves with first and second hook and loop attachment features. The Applicants assert that nowhere in the disclosure does *Odom* disclose the first and the second attachment features as recited in Claim 8 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests the invention of Claim 8 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments and for the same reasons as Claim 3.

**Claim 9.** Claim 9 is dependent from Claim 6 and contains all the limitations of Claim 6. Claim 9 adds the limitation that the third and fourth attachment features are mating elements selected from a group consisting of a hook and loop attachment system, a magnetic attachment system, or a selective, separable adhesive based attachment system. The Applicants have shown relative to Claim 6 that *Odom* does not disclose the third and fourth attachment features. The Applicants are not claiming a simple hook and loop attachment system, rather, the Applicants are claiming the specific first and second golf gloves with the third and fourth hook and loop attachment features recited in Claim 9. The Examiner did not specifically address Claim 9 except to reject Claim 9 for the same reasons as the Examiner rejected Claim 8. Office Action, at 5. The Applicants assert that nowhere in the disclosure does *Odom* disclose the third attachment feature and the fourth attachment features as recited in Claim 9 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests the invention of Claim 9 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments and for the same reasons as Claim 8.

**Claim 10.** Claim 10 is dependent from Claim 4 and contains all the limitations of Claim 4. Claim 10 adds a golf club with a modified golf grip having a fifth attachment feature for selectively coupling to said first location feature to align said first hand inserted in said first golf glove when gripping said modified golf grip. Claim 10 is directed to a golf aid that comprises a golf club with a modified golf grip

having a fifth attachment feature for selectively coupling to said first location feature and includes both the first and second golf gloves with the first, second, third, and fourth attachment features and the first location feature. While *Odom*, relative to Fig. 5, does teach an attachment feature for coupling to a cooperative attachment feature on a golf grip 42 on a golf club 40, *Odom* does not disclose all the elements in Claim 10 (including the limitations of Claims 2 and 4 from which it depends). Element 46 of *Odom* offers no help to a golfer in locating his hands on a golf club shaft. Element 46 of *Odom* broadly extends over nearly the entire palm surface of each of his glove 50 and his corresponding “mirror image” golf glove not shown. The cooperating element 42 on golf club 40 extends over the entire periphery of the grip and couples to element 46 but does not aid in locating the golfer’s hand and thus is not a location feature. The Applicants assert that nowhere in the disclosure does *Odom* disclose the fifth attachment feature as recited in Claim 10 of the present invention. The Examiner makes no assertion that *Harvanek* teaches or suggests the invention of Claim 10 of the present invention. Therefore, the Applicants respectfully assert that the rejection of Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* is traversed by the above arguments.

**Claims 13-24.** Claim 13 is written in independent form to include the limitations of Claims 11 and 12 which are canceled without prejudice or disclaimer. Accordingly, the rejections to Claims 1 and 12 are moot.

Claims 13-24 are directed to a method of teaching a golfer how to attain and maintain a correct golf grip on a golf club comprising the 4 steps. The Examiner states that Claims 13-24 are directed to the obvious method steps of using *Harvanek*’s device in view of *Odom*. Office Action, at 5. The Applicants have shown that *Harvanek* in view of *Odom* do not teach or suggest, singly or in combination, the golf teaching aid in Claims 2-10. Combining the teachings of *Harvanek* with the teachings of *Odom* does not lead to the invention of Claim 2 nor the method in amended Claim 13. *Odom* discloses two distinctly different embodiments both of which use a first golf glove and a “mirror image” second golf glove. The two

embodiments of *Odom* are directed to golf gloves with different elements. *Harvanek* teaches alignment markings and not attachment features of any kind. The Examiner fails to point out which of the embodiments of *Odom* combined with the disclosure of *Harvanek* teach the method steps of Claims 13-24. The Applicants have shown that *Odom* does not disclose the invention of amended Claims 2 and 3 or Claims 4-10. Since the Examiner fails to specifically address the method steps of Claims 13-24, the Examiner fails to make a *prima facie* case of obviousness relative to the reference *Harvanek* in view of *Odom*.

Therefore, the Applicants assert that the rejections of Claims 13-24 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom* are traversed by the above arguments. Accordingly, Applicants respectfully request the Examiner to withdraw these rejections.

#### IV. CONCLUSION

Claims 2-10 and 13-24 are pending.

Claims 1, 11 and 12 are canceled without prejudice or disclaimer.

The Applicants have traversed the rejections of Claims 2-10 and 13-24 under 35 U.S.C. § 103(a) as being unpatentable over *Harvanek* in view of *Odom*.

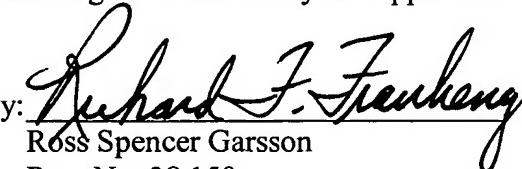
The Applicants, therefore, respectfully assert that Claims 2-10 and 13-24 are now in condition for allowance and requests an early allowance of these claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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